

REMARKS

Claims 1, 13-14, 17, 27, 57-62 and 196-199 are pending in the application. Claims 27 and 57-62 have been withdrawn from consideration as being drawn to a non-elected invention. Claims 1, 13-14, 17 and 196-199 have been examined on the merits. No new matter has been inserted into the application.

Maintained Rejection Under 35 U.S.C. §102(e) as being anticipated by Wreschner '324 (US 20050019324)

Claims 1, 13-14, and 196-198 have been rejected under 35 U.S.C. §102(e) as being anticipated by Wreschner '324. Applicant traverses this rejection. Reconsideration and withdrawal thereof are respectfully requested.

Wreschner'324 discloses antibody made against a region on MUC1 as follows:

[0043] The term "epitope" refers to the particular part of the antigen makes contact with a particular antibody. According to an embodiment of the invention, the epitope length is 4-12 amino acids. In another embodiment the epitope length is 5-10 amino acids, in yet another embodiment the epitope length is 6-8 amino acids. The epitope sequence is included within the 59 amino acid sequence as set forth in SEQ ID No. 1 and below:

(N-terminus) SVV VQLTLAFREG TINVHDVETQ FNQYKTEAAS
RYNLTISDVS VSDVPFFPSA QSGAGV (C-terminus)

[0044] In another embodiment the epitope is located in the 15 amino acid sequence that resides at the N-terminal portion of the 59 amino acid segment which is located directly N-terminal to the transmembrane domain of the MUC1/Y, MUC1/X and MUC1/REP proteins. The epitope is located in the extracellular region of the transmembrane isoform of the MUC1/Y, MUC1/X and MUC1/REP proteins.

Wreschner '324 discloses that its antibody was preferably made against the sequence located in the 15 amino acid sequence that resides at the N-terminal portion of the 59 amino acid segment. This 15 amino acid sequence includes SVVVQLTLAFREGGTI. However, only the final "GTI" overlaps with the PSMGFR sequence of the claimed invention. Accordingly,

it is believed that the Wreschner'324 antibody lies outside the scope of the antibody of the claimed invention.

Rejection Under 35 USC § 102(e) Over Bamdad '199 (US 2003/0036199)

Claims 1, 13-14, and 196-199 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Bamdad '199. Applicant traverses this rejection. Reconsideration and withdrawal thereof are respectfully requested.

Applicants submit herewith a renewed Petition under Rule 1.78 to accept an unintentionally delayed claim benefit, in which the present application claims the benefit of priority to a co-pending patent application. Thus, the present application is a 371 of PCT/US/04/27954, filed August 26, 2004, which claims priority to U.S. Provisional Patent Application No. 60/498,260, filed August 26, 2003, is a continuation-in-part application of U.S. Patent Application No. 09/996,069, filed November 27, 2001, now U.S. Patent No. 7,700,715, which claims the benefit of priority to U.S. provisional application No. 60/253,361, filed Nov. 27, 2000, U.S. provisional application No. 60/255,370, filed Dec. 13, 2000, U.S. provisional application No. 60/256,027, filed Dec. 15, 2000, U.S. provisional application No. 60/258,157, filed Dec. 22, 2000, U.S. provisional application No. 60/259,615, filed Jan. 3, 2001, U.S. provisional application No. 60/260,186, filed Jan. 5, 2001, U.S. provisional application No. 60/266,169, filed Feb. 2, 2001, U.S. provisional application No. 60/289,444, filed May 7, 2001, U.S. provisional application No. 60/266,929, filed Feb. 6, 2001, U.S. provisional application No. 60/278,093, filed Mar. 23, 2001, U.S. provisional application No. 60/294,887, filed May 31, 2001, and U.S. provisional application No. 60/298,272, filed Jun. 14, 2001.

Since the priority date for the present application is identical to the cited Bamdad '199 reference, Bamdad '199 fails to be citable against the presently claimed invention. Accordingly, removal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. §103(a) Over Kufe et al. '685 (WO 02/22685) In View Of Bamdad et al. '199 (US 2003/0036199)

Claims 1, 17, 196 and 199 have been rejected under 35 U.S.C. §103(a) as being "obvious" over Kufe et al. '685 in view of Bamdad et al. '199. Applicant traverses this rejection. Reconsideration and withdrawal thereof are respectfully requested.

The Bamdad '199 patent is not citable against the presently claimed invention, in view of the submission of the Petition under 27 C.F.R. 1.78 for the present application to claim priority to Bamdad '199. Therefore, it is believed that this rejection has been overcome.

Rejection Under 35 U.S.C. §103(a) Over Wreschner '324 (US 20050019324) In View of Kufe '685 (WO/0222685)

Claims 17 and 199 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Wreschner '324 in view of Kufe '685. Applicant traverses this rejection. Reconsideration and withdrawal thereof are respectfully requested. Applicant submits that in view that Wreschner '324 fails to disclose or suggest the presently claimed invention, as discussed above, it is believed that Kufe '685 fails to remedy this defect. Accordingly, it is believed that the presently claimed invention is not obvious over the cited references.

Conclusion

It is believed that the application is now in condition for allowance. Applicants request the Examiner to issue a notice of Allowance in due course. The Examiner is encouraged to contact the undersigned to further the prosecution of the present invention.

The Commissioner is authorized to charge JHK Law's Deposit Account No. **502486** for any fees required under 37 CFR § 1.16 and 1.17 and to credit any overpayment to said Deposit Account No. **502486**.

Respectfully submitted,

JHK Law

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